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PATENT

**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicant : David Allison Bennett, et al.  
Application No.: 09/685,078  
Filed : October 6, 2000  
Title : APPARATUS, SYSTEMS AND METHODS FOR ONLINE, MULTI-CARRIER, MULTI-SERVICE PARCEL SHIPPING MANAGEMENT FEATURING NOTIFICATION SERVICE OPTION COMPARISON FOR MULTIPLE CARRIERS  
Technology  
Center : 3600  
Grp./Div. : 3629  
Examiner : Plucinski, Jamisue A.  
Docket No. : PSTM0010/MRK

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P.O. Box 1450  
Alexandria, VA 22313-1450

140 S. Lake Ave., Suite 312  
Pasadena, CA 91101-4710  
November 21, 2007

**APPEAL BRIEF**

This is an appeal from a final rejection of the Examiner, dated May 21, 2007, rejecting all claims currently under examination in the case, namely Claims 1-6, 28-33, 49-52, and 58.

Applicants file this Appeal under 37 C.F.R. §41.31(a), all claims having been twice rejected.

The requisite fee set forth in 37 C.F.R. §41.20(b)(1) for filing a Notice of Appeal was presented with the filing of the Notice of Appeal which was filed via First Class U.S. Mail on August 20, 2007 with a Certificate of Mailing.

The requisite fee set forth in 37 C.F.R. §41.20(b)(2) for filing this Appeal Brief is presented herewith.

The U.S. Patent Office PAIR System identifies August 22, 2007 as the date on which the Notice of Appeal was received by the Patent Office. Under 37 CFR §41.37 and in accordance with MPEP §1205.01, the two-month period in which an Appeal Brief

could be filed without extension ended on October 22, 2007. A Petition for an Extension of Time for one month and the corresponding fee are filed concurrently herewith to extend the time in which to file the Appeal Brief until November 22, 2007 in accordance with 37 CFR §§41.37(e) and 1.136. Because November 22, 2007 is a federal holiday (Thanksgiving), it is respectfully submitted that this Appeal Brief is timely filed within the one-month extension period under 37 C.F.R. §§ 41.37(e), and 1.136, because it is filed before the expiration of November 23, 2007, which is the first business day following the one-month extension period.

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**REAL PARTIES IN INTEREST (37 C.F.R. §41.37(c)(1)(i) heading)**

In an Assignment, Inventors David Allison Bennett, Scott Meyer, Paul Bilibin, Jinyue Liu, and Gary Rhoe Ingram, assigned the entire right, title and interest in and to the instant application to STAMPS.COM INC., as recorded by the Assignment Division of the United States Patent and Trademark Office on March 13, 2001 on Reel No. 011629 and Frame No. 0799. In a subsequent Intellectual Property Joint Ownership Agreement Notice of Assignment, STAMPS.COM INC. noticed the assignment of an undivided whole interest in common in all rights, title, and interest in and to the present application to both STAMPS.COM INC. and ISHIP INC., as recorded by the Assignment Division of the United States Patent and Trademark Office on March 26, 2004 on Reel No. 014466 and Frame No. 0275. Statements by both STAMPS.COM INC. and ISHIP INC. under 37 C.F.R. §3.73(b) are filed concurrently herewith.

ISHIP INC. is a fully owned subsidiary of UNITED PARCEL SERVICE OF AMERICA, INC., which is a fully owned subsidiary of UNITED PARCEL SERVICE, INC.

Accordingly, STAMPS.COM INC., ISHIP INC., UNITED PARCEL SERVICE OF AMERICA, INC., and UNITED PARCEL SERVICE, INC. are the real parties in interest in this case.

**RELATED APPEALS AND INTERFERENCES (37 C.F.R. §41.37(c)(1)(ii) heading)**

Applicants have not previously presented the current claim set to the Board in an Appeal Brief and there are no related appeals or interferences known to Appellants, or known to Appellants' legal representative, regarding the current claim set.

However, there is an Appeal pending in the case of related U.S. Patent Application No. 09/684,861 (Applicants Bilibin, Paul et al.; Filed October 6, 2000; Entitled "Apparatus, Systems and Methods for Determining Delivery Time Schedules for Each of Multiple Carriers"; Attorney Docket No. PSTM0024/MRK; Technology Center 3600; Group/Div. 3623; Examiner Beth Van Doren). No opinion has yet been rendered in that case.

A Notice of Appeal has been filed for the case of related U.S. Patent Application No. 09/684,866 (Attorney Docket No. PSTM0038/MRK; Technology Center 3600; Group/Div. 3629; Examiner Jamisue A. Plucinski).

Further, there is an Appeal pending in the case of related U.S. Patent Application No. 09/680,654 (Applicants David Allison Bennett, et al., Filed October 6, 2000; Entitled "Apparatus, Systems and Methods for Online, Multi-Carrier, Multi-Service Parcel Shipping Management Featuring Shipping Rate and Delivery Schedule Comparison for Multiple Carriers"; Attorney Docket No. PSTM0015/MRK; Technology Center 3600; Group/Div. 3629; Examiner Jamisue A. Plucinski). No opinion has yet been rendered in that case.

Yet further, there is an Appeal pending in the case of related U.S. Patent Application No. 09/685,077 (Applicants Paul Bilibin, et al., Filed October 6, 2000; Entitled "Apparatus, Systems and Methods for Online, Multi-Carrier, Multi-Service Parcel Shipping Management Determination of Ratable Weight for Multiple Carriers"; Attorney Docket No. PSTM0020/MRK; Technology Center 3600; Group/Div. 3629; Examiner Jamisue A. Plucinski). No opinion has yet been rendered in that case.

Further still, there is an Appeal pending in the case of related U.S. Patent Application No. 09/820,377 (Applicants Daniel F. Williams, et al., Filed March 27, 2001; Entitled "Apparatus, Systems and Methods for Online, Multi-Parcel, Multi-Carrier, Multi-Service Enterprise Parcel Shipping Management"; Attorney Docket No. PSTM0041/MRK; Technology Center 3600; Group/Div. 3629; Examiner Jamisue A. Plucinski). No opinion has yet been rendered in that case.

An Appeal was filed in the case of related co-pending U.S. Patent Application No. 09/684,871 (Applicants David Allison Bennett, et al., Filed October 6, 2000; Entitled "Apparatus, Systems And Methods For Online, Multi-Carrier, Multi-Service Parcel Shipping Management Featuring Shipping Location Comparison Across Multiple Carriers"; Attorney Docket No. PSTM0003/MRK; Technology Center 3600; Group/Div. 3629; Examiner Jamisue A. Plucinski). The Examiner in that case has since issued a

new Office Action, reopening prosecution of the application. Subsequently, another Notice of Appeal has been filed.

Prior to filing an Appeal in the case of related co-pending U.S. Patent Application No. 09/684,871 (Attorney Docket No. PSTM0003/MRK), a Pre-Appeal Brief Request for Review was filed for that application. A copy of the Notice of Panel Decision from Pre-Appeal Brief Request for Review for Application No. 09/684,871 is included in the Related Proceedings Appendix hereto.

Prior to filing an Appeal Brief in the case of the above-mentioned pending Appeal for Application No. 09/684,861 (Attorney Docket No. PSTM0024/MRK), a Pre-Appeal Brief Request for Review was filed for that application. A copy of the Notice of Panel Decision from Pre-Appeal Brief Request for Review for Application No. 09/684,861 is included in the Related Proceedings Appendix hereto.

Further, prior to filing an Appeal Brief in the case of the above-mentioned Appeal for Application No. 09/680,654 (Attorney Docket No. PSTM0015/MRK), a Pre-Appeal Brief Request for Review was filed for that application. A copy of the Notice of Panel Decision from Pre-Appeal Brief Review for Application No. 09/680,654 is included in the Related Proceedings Appendix hereto.

Yet further, prior to filing an Appeal Brief in the case of the above-mentioned Appeal for Application No. 09/685,077 (PSTM0020/MRK), a Pre-Appeal Brief Request for Review was filed for that application. A copy of the Notice of Panel Decision from Pre-Appeal Brief Review for Application No. 09/685,077 is included in the Related Proceedings Appendix hereto.

**STATUS OF CLAIMS (37 C.F.R. §41.37(c)(1)(iii) heading)**

The present application was filed on October 6, 2000, claiming priority under 37 C.F.R. §1.78(a)(4) to: U.S. Provisional Patent Application Serial No. 60/158,179, filed on October 6, 1999; U.S. Provisional Patent Application Serial No. 60/170,186, filed on December 10, 1999; U.S. Provisional Patent Application Serial No. 60/170,504, filed on December 13, 1999; U.S. Provisional Patent Application Serial No. 60/192,692, filed on



March 28, 2000; U.S. Provisional Patent Application Serial No. 60/192,723, filed on March 27, 2000; U.S. Provisional Patent Application Serial No. 60/193,899, filed on March 31, 2000; and U.S. Provisional Patent Application Serial No. 60/195,748, filed on April 6, 2000.

The status of the Claims is as follows:

Allowed Claims: None.

Cancelled Claims: 7-27, 34-48 and 53-57.

Withdrawn Claims: 59-65.

Claims objected to: None.

Rejected Claims: 1-6, 28-33, 49-52, and 58.

**Claims on Appeal: 1-6, 28-33, 49-52, and 58.**

**STATUS OF AMENDMENTS (37 C.F.R. §41.37(c)(1)(iv) heading)**

No amendments subsequent to the final Office Action, dated May 21, 2007, have been filed.

**SUMMARY OF CLAIMED SUBJECT MATTER (37 C.F.R. §41.37(c)(1)(v) heading)**

The Claims on Appeal are Claims 1-6, 28-33, 49-52, and 58. Of the Claims on appeal, Claims 1, 28, 49, 50, 51, 52 and 58 are independent. It is respectfully submitted that none of the Claims on appeal are means plus function claims.

In compliance with 37 C.F.R. § 41.37(c)(1)(v), the subject matter of the independent claims on appeal is explained below with citations to the Specification of the present application ("Specification") as disclosed with respect to exemplary embodiments. Unless otherwise specified, citations below to the Specification are to page and line numbers of the application as originally filed.

**Claims 1, 28, 49 and 50**

Claims 1 and 49 are directed to server-based shipping management computer

systems that comprise at least one server computer device. Claims 28 and 50 are directed to server-based shipping management computer systems comprising at least one computer device.

It is respectfully submitted that various exemplary embodiments of the aforementioned recitations of Claims 1, 28, 49 and 50 are described in the Specification. See, e.g., Specification, Title; Specification, Abstract; Specification, p. 18, lines 17-23 (describing FIG. 4).

Claim 1 further recites that the shipping management computer system is programmed to, among other things, "... receive from a particular user client computer device of a plurality of user client computer devices, a request input by a user for an electronic mail delivery notification service by a carrier system for shipping a particular parcel and an input by the user of parcel specifications for the particular parcel...."

It is respectfully submitted that various exemplary embodiments of the aforementioned recitations of Claim 1 are described in the Specification. See, e.g., Specification, p. 3, lines 12-23; Specification, p. 37, line 22-p. 38, line 2; Specification, p. 38, lines 16-23.

Claims 28, 49 and 50 recite similar limitations. Claim 28 recites "...receive from a particular user client computer devices of a plurality of user client computer devices, a request input by a user for a verbal delivery notification service by a carrier for shipping a particular parcel and an input by the user of parcel specifications for the particular parcel ...."

It is respectfully submitted that various exemplary embodiments of the aforementioned recitations of Claim 28 are described in the Specification. See, e.g., Specification, p. 3, lines 12-23; Specification, p. 37, line 22 - p. 38, line 2; Specification, p. 38, line 24 – p. 39, line 1.

Claim 49 recites "...receive from a particular user client computer device of a plurality of user client computer devices, a request input by a user for a plurality of delivery notification service options for shipping a particular parcel and an input by the user of parcel specifications for the particular parcel ...."

It is respectfully submitted that various exemplary embodiments of the aforementioned recitations of Claim 49 are described in the Specification. See, e.g., Specification, p. 3, lines 12-23; Specification, p. 37, line 22 - p. 38, line 2; Specification, p. 38, lines 16-23; Specification, p. 38, line 24 – p. 39, line 1.

Claim 50 recites "...receive from an at least one respective user of a plurality of users, a respective request for an at least one delivery notification service option of a plurality of delivery notification service options for shipping a respective particular parcel ...."

It is respectfully submitted that various exemplary embodiments of the aforementioned recitations of Claim 50 are described in the Specification. See, e.g., Specification, p. 3, lines 12-23; Specification, p. 37, line 22 - p. 38, line 2; Specification, p. 38, lines 16-23; Specification, p. 38, line 24 – p. 39, line 1.

Claim 1 further recites that "...for each respective carrier of a plurality of carriers, determine whether the respective carrier would provide electronic mail delivery notification for shipping the particular parcel according to the request ...." Claims 28, 49 and 50 recite similar limitations regarding verbal delivery notification and delivery notification options.

It is respectfully submitted that various exemplary embodiments of the aforementioned recitations of Claims 1, 28, 49 and 50 are described in the Specification. See, e.g., Specification, p. 64, lines 18-27; Specification, p. 64, line 28 – p. 65, line 9; Specification, p. 54, line 27 – p. 55, line 6; Specification, p. 56, lines 21-28; Specification, p. 58, line 22 – p. 59, line 8.

Claim 1 further recites that "...for each respective carrier of the plurality of carriers that would provide electronic mail delivery notification for shipping the particular parcel according to the request, display to a display device configured for communication with the particular user client computer device of the user, as to the particular parcel, a simultaneous identification of shipping charges for each delivery service offered by the respective carrier to ship the particular parcel according to the parcel shipping specifications." Claims 28, 49 and 50 recite similar limitations regarding

verbal delivery notification and delivery notification options.

It is respectfully submitted that various exemplary embodiments of the aforementioned recitations of Claims 1, 28, 49 and 50 are described in the Specification. See, e.g., FIG. 40 and corresponding description at Specification, p. 66, lines 22-24; FIG. 36a and corresponding description at Specification, p. 47, line 28 – p. 54, line 18; FIG. 36f and corresponding description at Specification, p. 55, line 26 – p. 57, line 10.

### **Claims 51 and 52**

Claim 51 is directed to a shipping management computer system comprising at least one computer device. Claim 52 is directed to a method using a computer system for managing shipping of a plurality of parcels shipped by any one of a plurality of carriers, wherein said computer system comprises at least one computer device.

It is respectfully submitted that various exemplary embodiments of the aforementioned recitations of Claims 51 and 52 are described in the Specification. See, e.g., Specification, Title; Specification, Abstract; Specification, p. 18, lines 17-23 (describing FIG. 4).

Claim 51 further recites that the shipping management computer system is programmed to, among other things, "... simultaneously identify to a respective user of a plurality of users, in response to the respective user's request for at least one delivery notification service option of a plurality of delivery notification service options for shipping a respective parcel, each delivery service offered by each respective carrier of a plurality of carriers that would support each delivery notification service option requested by the respective user for delivery of the respective parcel."

Claim 52 similarly recites that the claimed method comprises "... displaying to a respective user of a plurality of users, in response to the respective user's request for at least one delivery notification service option of a plurality of delivery notification service options for shipping a respective parcel, a simultaneous identification of each delivery service offered by each respective carrier of a plurality of carriers that would provide the

delivery notification service options requested by the respective user for shipping the respective parcel.”

It is respectfully submitted that various exemplary embodiments of the aforementioned recitations of Claims 51 and 52 are described in the Specification. See, e.g., Specification, p. 3, lines 12-23; Specification, p. 37, line 22 - p. 38, line 2; Specification, p. 38, lines 16-23; Specification, p. 38, line 24 – p. 39, line 1. See also, e.g., Specification, p. 64, lines 18-27; Specification, p. 64, line 28 – p. 65, line 9; FIG. 40 and corresponding description at Specification, p. 66, lines 22-24; FIG. 36a and corresponding description at Specification, p. 47, line 28 – p. 54, line 18; FIG. 36f and corresponding description at Specification, p. 55, line 26 – p. 57, line 10; Specification, p. 54, line 27 – p. 55, line 6; Specification, p. 58, line 22 – p. 59, line 8.

#### **Claim 58**

Claim 58 is directed to a shipping management computer system.

It is respectfully submitted that various exemplary embodiments of the aforementioned recitations of Claim 58 are described in the Specification. See, e.g., Specification, Title; Specification, Abstract; Specification, p. 18, lines 17-23 (describing FIG. 4).

Claim 58 recites “... allowing a user to select, via a notification option selection, an electronic mail delivery notification option to be offered in conjunction with a delivery of a parcel ... [and] ... receiving said notification option selection from said user ...”

It is respectfully submitted that various exemplary embodiments of the aforementioned recitations of Claim 58 are described in the Specification. See, e.g., Specification, p. 3, lines 12-23; Specification, p. 37, line 22-p. 38, line 2; Specification, p. 38, lines 16-23.

Claim 58 further recites “... in response to receiving said notification option selection ... identifying, from a plurality of carriers, a first carrier that would offer an electronic mail delivery notification service in conjunction with performing said delivery of the parcel, and ... identifying, from said plurality of carriers, a second carrier that

would offer an electronic mail delivery notification service in conjunction with performing said delivery of the parcel ....”

It is respectfully submitted that various exemplary embodiments of the aforementioned recitations of Claim 58 are described in the Specification. See, e.g., Specification, p. 64, lines 18-27; Specification, p. 64, line 28 – p. 65, line 9; Specification, p. 54, line 27 – p. 55, line 6; Specification, p. 56, lines 21-28; Specification, p. 58, line 22 – p. 59, line 8.

Claim 58 further recites “...for each delivery service offered by said first carrier, using a first set of electronic mail delivery notification rules defined by said first carrier for the respective delivery service to calculate a respective service-specific service charge that said first carrier would charge for providing an electronic mail delivery notification service in conjunction with performing said delivery of the parcel according to the respective delivery service ... [and] ... for each delivery service offered by said second carrier, using a second set of electronic mail delivery notification rules defined by said second carrier for the respective delivery service to calculate a respective service-specific service charge that said second carrier would charge for providing an electronic mail delivery notification service in conjunction with performing said delivery of the parcel according to the respective delivery service ....”

It is respectfully submitted that various exemplary embodiments of the aforementioned recitations of Claim 58 are described in the Specification. See, e.g., Specification, p. 64, lines 18-27; Specification, p. 64, line 28 – p. 65, line 9; Specification, p. 54, line 27 – p. 55, line 6; Specification, p. 56, lines 21-28; Specification, p. 58, line 22 – p. 59, line 8.

Claim 58 further recites “... simultaneously displaying on a display screen associated with said user: ... a first respective service-specific shipping charge that said first carrier would charge in conjunction with performing said delivery of the parcel according to a first respective delivery service offered by said first carrier, said first respective service-specific shipping charge calculated to include a first respective service-specific service charge associated with the first respective delivery service

providing an electronic mail delivery notification for the delivery of the parcel, ... a second respective service-specific shipping charge that said first carrier would charge in conjunction with performing said delivery of the parcel according to a second respective delivery service offered by said first carrier, said second respective service-specific shipping charge calculated to include a second respective service-specific service charge associated with the second respective delivery service providing an electronic mail delivery notification for the delivery of the parcel, ... a third respective service-specific shipping charge that said second carrier would charge in conjunction with performing said delivery of the parcel according to a third respective delivery service offered by the second carrier, said third respective service-specific shipping charge calculated to include a third respective service-specific service charge associated with the third respective delivery service providing an electronic mail delivery notification for the delivery of the parcel, and ... a fourth respective service-specific shipping charge that said second carrier would charge in conjunction with performing said delivery of the parcel according to a fourth respective delivery service offered by said second carrier, said fourth respective service-specific shipping charge calculated to include a fourth respective service-specific service charge associated with the fourth respective delivery service providing an electronic mail delivery notification for the delivery of the parcel."

It is respectfully submitted that various exemplary embodiments of the aforementioned recitations of Claim 58 are described in the Specification. See, e.g., FIG. 40 and corresponding description at Specification, p. 66, lines 22-24; FIG. 36a and corresponding description at Specification, p. 47, line 28 – p. 54, line 18; FIG. 36f and corresponding description at Specification, p. 55, line 26 – p. 57, line 10.

**GROUND OF REJECTION TO BE REVIEWED ON APPEAL (37 C.F.R.**

**§41.37(c)(1)(vi) heading)**

In the Office Action, Claims 1-6, 49-52 and 58 were rejected under 35 U.S.C. §103(a) as being unpatentable over Nicholls et al. (U.S. Patent No. 5,485,369; "Nicholls") in view of Fisher et al. (U.S. Patent No. 6,047,264; "Fisher"), Kara et al. (U.S.

Patent No. 6,233,568; "Kara") and Thiel (U.S. Patent No. 5,699,258; "Thiel"). Office Action, Topic Nos. 5-13, pgs. 2-5.

In the Office Action, Claims 28-33 were rejected under 35 U.S.C. §103(a) as being unpatentable over Nicholls in view of Pauley et al. (U.S. Patent No. 4,958,280; "Pauley"), Kara and Thiel. Office Action, Topic Nos. 14-21, pgs. 5-7.

For convenient reference, copies of Nicholls, Kara, Thiel, Fisher and Pauley are included in the Evidence Appendix hereto.

**Issue 1 Regarding the Rejection of Independent Claims 1, 49, 50, 51, 52, and 58, and Dependent Claims 2-6, Under 35 U.S.C. §103(a) as Unpatentable over Nicholls in View of Fisher, Kara and Thiel on the Grounds that the Combination of Nicholls, Fisher, Kara and Thiel Render as Obvious the Limitations of the Claims for Determining/Identifying Whether Each Respective Carrier of a Plurality of Carriers Would Provide the Requested Type of Delivery Notification for Shipping a Particular Parcel**

**Issue 2 Regarding the Rejection of Independent Claims 1, 49, 50, 51, 52, and 58, and Dependent Claims 2-6, Under 35 U.S.C. §103(a) as Unpatentable over Nicholls in View of Fisher, Kara and Thiel on the Grounds that the Combination of Nicholls, Fisher, Kara and Thiel Render as Obvious the Limitations of the Claims for Displaying a Simultaneous Identification of Shipping Charges for Shipping the Particular Parcel for Each Delivery Service Offered by Each Respective Carrier of the Plurality of Carriers That Would Provide the Requested Delivery Notification Service According to the Request**

**Issue 3 Regarding the Rejection of Independent Claim 28, and Dependent Claims 29-33, Under 35 U.S.C. §103(a) as Unpatentable over Nicholls in View of Pauley, Kara and Thiel on the Grounds that the Combination of Nicholls, Pauley, Kara and Thiel Render as Obvious the Limitations of Claim 28 for Determining**



**Whether Each Respective Carrier of a Plurality of Carriers Would Provide Verbal Delivery Notification for Shipping a Particular Parcel**

**Issue 4 Regarding the Rejection of Independent Claim 28, and Dependent Claims 20-33, Under 35 U.S.C. §103(a) as Unpatentable over Nicholls in View of Pauley, Kara and Thiel on the Grounds that the Combination of Nicholls, Pauley, Kara and Thiel Render as Obvious the Limitations of the Claims for Displaying a Simultaneous Identification of Shipping Charges for Shipping the Particular Parcel for Each Delivery Service Offered by Each Respective Carrier of the Plurality of Carriers That Would Provide the Requested Verbal Delivery Notification Service**

**ARGUMENT (37 C.F.R. §41.37(c)(1)(vii) heading)**

**Issue 1 Argument Regarding the Rejection of Independent Claims 1, 49, 50, 51, 52, and 58, and Dependent Claims 2-6, Under 35 U.S.C. §103(a) as Unpatentable over Nicholls in View of Fisher, Kara and Thiel on the Grounds that the Combination of Nicholls, Fisher, Kara and Thiel Render as Obvious the Limitations of the Claims for Determining/Identifying Whether Each Respective Carrier of a Plurality of Carriers Would Provide the Requested Type of Delivery Notification for Shipping a Particular Parcel: There is No Disclosure in Nicholls, Fisher, Kara or Thiel of Determining/Identifying Whether Each Respective Carrier of a Plurality of Carriers Would Provide the Requested Type of Delivery Notification Service for Shipping a Particular Parcel (37 C.F.R. §41.37(c)(1)(vii) subheading)**

For the reasons given and the authorities cited below, it is respectfully asserted that Claims 1, 49-52 and 58, and therefore dependent Claims 2-6, are patentably distinguished from the references of record. It is therefore respectfully requested that the rejection of Claims 1, 49-52 and 58, and therefore dependent Claims 2-6, be reversed and that those Claims be allowed. In particular, it is respectfully asserted that none of references of record, whether considered alone or in combination, disclose, anticipate, teach or suggest all of the limitations recited in independent Claims 1, 49-52 and 58 as discussed in detail in the following paragraphs.

Based on Fig. 4A of Nicholls cited in the Office Action as a basis for rejecting Claims 1, 49-52 and 58 (see, e.g., Office Action, Topic No. 7, p. 3), it appears that a user may designate any one of a number of Special Services, such as, for example, Proof of Delivery, and that the Nicholls system will, as a result, calculate a rate that includes any charge for the Special Services designated. Based on Fig. 4A of Nicholls, it therefore appears that Nicholls presumes that all carriers offer each of the listed Special Services, and thus does not teach determining or identifying whether each respective carrier of a plurality of carriers would provide the requested type of delivery notification service for shipping a particular parcel, which is claimed in one way or another by independent Claims 1, 49-52 and 58.

Further, it is respectfully asserted that it may be possible for a carrier to provide a

Special Service, such as, for example, a Proof of Delivery, without requiring any additional charge. Therefore, in the event a rate were calculated that did not include an extra charge for a Special Service indicated by a user, such as a Proof of Delivery service, such a rate, by itself, would not identify whether the carrier provided the service or did not.

Moreover, the Office Action actually concedes that “Nicholls ... fails to disclose determining whether a carrier would provide a specific service....” Office Action, Topic No. 8, p. 3.

The Office Action asserts that “Kara discloses a computer program used for multiple shippers that determines if a carrier provides a specific service....” Office Action, Topic No. 8, p. 3 (citing Kara, col. 22, lines 13-48). However, as compared to identifying or determining carrier support for providing a particular special service with respect to a particular parcel as claimed in one way or another by Claims 1, 49-52 and 58, and therefore dependent Claims 2-6, the cited portion of Kara explains that “[t]he E-STAMP program will automatically incorporate the ... entered parameters—weight, class, zone—in order to correctly calculate the correct postage ... Where a selected shipping service provider does not provide a desired shipping and/or delivery parameter, the E-STAMP program may indicate such and provide the fees for a service offered by that particular shipping service provider most near that desired by the user.” Kara, col. 22, lines 13-38.

Notwithstanding the above-cited assertions by the Office Action, it is respectfully asserted that the above-cited disclosure of Kara does not disclose any facility for user input of an indication of any type of special service of a nature of the type claimed. Rather, according to the above-cited disclosure, Kara discloses consideration of “desired shipping and/or delivery parameters” and mentions the “entered parameters” of “weight, class, zone.” It is respectfully asserted that basic parcel specifications such as weight, and basic shipping parameters such as class and zone, are distinguished from special services that may, or may not be provided by particular carriers.

Moreover, even if it were assumed for the sake of argument only that Kara's consideration of basic parcel specifications and basic shipping parameters could be considered to be special service options of the nature of the type claimed, it is respectfully asserted that the above-cited disclosure of Kara fails to disclose, anticipate, teach or suggest identifying or determining, for each respective carrier of a plurality of carriers, whether a respective carrier would provide electronic mail delivery notification for shipping *a particular parcel according to specifications of a user's request*.

It is therefore respectfully asserted that none of the cited references, including Nicholls and Kara, disclose that some carriers may provide a particular special service, and that some carriers may not, with respect to a particular parcel. Moreover, it is respectfully asserted that none of the cited references, including Nicholls and Kara, disclose identifying or determining whether or not a carrier would provide a particular special service with respect to a particular parcel.

As compared to the apparent assumption by some of the references of record that all carriers provide special services, or in the case, for example, of Kara, that if a carrier provides a certain service, that it would do so with respect to all parcels, the Specification of the present application explains:

One of the problems in dealing with standalone Carrier systems is that, if the Shipper wants electronic mail ("e-mail") notification that a particular parcel has been delivered, the Shipper must attempt to apply each Carrier's rules for providing a Shipper with electronic mail notification that a particular parcel has been delivered. *Each Carrier's electronic mail delivery notification pricing rules must be separately applied by the Shipper to shipment of a particular parcel to determine whether or not the particular Carrier offers electronic mail delivery notification and if so, the price for the service.*

Specification, p. 2, lines 19-25 (emphasis added). It is respectfully asserted that, for example, Claim 1 recites limitations that reflect the above-mentioned disclosure of the specification.

For example, as compared to the apparent assumption by some of the references of record that all carriers provide special services, or in the case, for example, of Kara, that if a carrier provides a certain service, that it would do so with

respect to all parcels, Claim 1 recites the limitations "...for each respective carrier of the plurality of carriers *that would provide electronic mail delivery notification for shipping the particular parcel according to the request ....*" (Emphasis added).

Similar to Claim 1, Claim 49 recites the limitation "...for each respective carrier of a plurality of carriers, *determine whether the respective carrier would provide each of the plurality of delivery notification service options* for shipping the particular parcel according to the request ...." (Emphasis added).

Similarly, Claim 50 recites the limitation "...for each respective carrier of a plurality of carriers, for each respective delivery notification service option of the at least one delivery notification service options, *determine whether the respective carrier would provide the respective delivery notification service option* for shipping the particular parcel according to the request ...." (Emphasis added).

Similarly, Claim 51 recites the limitations "...*simultaneously identify* to a respective user of a plurality of users, in response to the respective user's request for at least one delivery notification service option of a plurality of delivery notification service options for shipping a respective parcel, *each delivery service offered by each respective carrier of a plurality of carriers that would support each delivery notification service option requested by the respective user for delivery of the respective parcel.*" (Emphasis added).

Similarly, Claim 52 recites the limitations "...displaying to a respective user of a plurality of users, in response to the respective user's request for at least one delivery notification service option of a plurality of delivery notification service options for shipping a respective parcel, a *simultaneous identification* of each delivery service offered by *each respective carrier of a plurality of carriers that would provide the delivery notification service options* requested by the respective user for shipping the respective parcel." (Emphasis added).

Yet further, similar to the determining limitations of Claims 1, 28, and 49-52 Claim 58 recites the following limitations for identifying carriers that would provide an electronic mail delivery notification service:

(C) in response to receiving said notification option selection:

- (1) identifying, from a plurality of carriers, a first carrier that would offer an electronic mail delivery notification service in conjunction with performing said delivery of the parcel, and
- (2) identifying, from said plurality of carriers, a second carrier that would offer an electronic mail delivery notification service in conjunction with performing said delivery of the parcel;

It is respectfully asserted that the above-recited limitations by Claims 1, 49-52 and 58, and therefore dependent Claims 2-6 are distinguished from the references of record.

Therefore, it is respectfully asserted that none of the references of record disclose, anticipate, teach or suggest identifying or determining which of a plurality of carriers would provide for delivery of a particular parcel, a delivery notification service and which do not, as claimed in one way or another by Claims 1, 49-52 and 58, and therefore dependent Claims 2-6.

The Office Action concedes that "Nicholls ... fails to disclose the specific delivery requirements includes an electronic mail delivery notification ..." (Office Action, Topic No. 7, p. 3), but asserts that "Fisher discloses a method for supplying automatic status updates using e-mail (See abstract) ..." and asserts that "[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to have the proof of delivery of Nicholls be the electronic notification system, as disclosed by Fisher ...." Office Action, Topic No. 7, p. 3. The Office Action further asserts that the aforementioned combination "... would have been obvious ... in order to automatically send delivery status messages over email without the aid or need of a human customer service representative [citing Fisher, cols. 1 and 2]." Office Action, Topic No. 7, p. 3.

As compared to the reasoning of the Office Action that it would have been obvious to make the asserted combination "... in order to automatically send delivery status messages over email ...," it is respectfully submitted that none of Claims 1-6, 49-52 and 58 are directed to supplying, or in any way providing, automatic status updates using email. Rather, Claim 1, for example, recites the limitations to "...receive ... a

request input by a user for an electronic mail delivery notification service by a carrier system for shipping a particular parcel ..." and then, "... for each respective carrier of the plurality of carriers that would provide electronic mail delivery notification for shipping the particular parcel according to the request, display ... a simultaneous identification of shipping charges for each delivery service offered by the respective carrier to ship the particular parcel according to the parcel shipping specifications."

Further still, as compared to the reasoning of the Office Action that it would have been obvious to make the asserted combination "... in order to automatically send delivery status messages over email ...," it is respectfully asserted that there is no disclosure in Fisher of the Fisher carriers themselves providing any type of delivery notification. Rather, in Fisher, as further explained below, the Fisher system interrogates a carrier's system to determine the status of a customer's respective shipment; the Fisher system then composes an email message to the respective customer regarding the status of the customer's respective shipment.

Moreover, for the following reasons and authorities, it is respectfully asserted that the combination of Fisher with Nicholls and the other references of record, adds nothing to support the rejection of Claims 1-6, 49-52 and 58. That is because, as further explained below, the disclosure of Fisher is fundamentally different than the limitations of independent Claims 1, 49-52 and 58, and their respective dependent Claims 2-6.

Fisher discloses a merchant system that tracks shipment status of a customer's order sent by a particular merchant using a particular carrier to the respective ordering customer. Fisher, col. 2, lines 12 – 18. According to Fisher, the Fisher system interrogates the carrier's system to determine the shipping status of the respective order. Fisher, col. 2, lines 12 – 18. The Fisher system then composes and sends an email notice to the respective ordering customer regarding their respective order shipment status. Fisher, col. 2, lines 12 – 18. It is respectfully asserted that there is no disclosure in Fisher of the Fisher carriers themselves providing any type of delivery notification.

As distinguished from a system such as the one disclosed in Fisher that itself composes a shipment status email message based on a carrier-system interrogation, it is respectfully asserted that Claim 1, for example, recites limitations that "...for each respective carrier of a plurality of carriers, *determine whether the respective carrier would provide electronic mail delivery notification* for shipping the particular parcel according to the request." (Emphasis added).

As further distinguished from a system such as disclosed in Fisher that itself composes a shipment status email message based on a carrier-system interrogation, it is respectfully asserted that Claim 1, for example, recites limitations that "... for each respective carrier of the plurality of carriers that would provide electronic mail delivery notification for shipping the particular parcel ... display ... a simultaneous identification of shipping charges for each delivery service offered by the respective carrier to ship the particular parcel according to the parcel shipping specifications..." (emphasis added) (See also, similar limitations of Claims 49-52 and 58). That is, as compared to the Fisher system that itself provides shipment status, Claim 1, for example, is directed to determining which carriers would provide electronic mail delivery notification and then providing a simultaneous display of shipping charges for various carriers and various delivery services that would provide delivery notification for shipping a parcel.

Yet further, it is respectfully asserted that, as distinguished from the Fisher system composition of an email message to a customer, Claim 1, for example, recites "...receiv[ing] ... a request input by a user for an electronic mail delivery notification service by a carrier system for shipping a particular parcel ..." and then, "... for each respective carrier of the plurality of carriers that would provide electronic mail delivery notification for shipping the particular parcel according to the request, display[ing] ... a simultaneous identification of shipping charges for each delivery service offered by the respective carrier to ship the particular parcel according to the parcel shipping specifications."

In view of the above-described distinctions between the disclosures of the cited references on the one hand, and independent Claims 1, 49-52 and 58, and their



respective dependent Claims 2-6, on the other hand, it is respectfully asserted, for the reasons given above, that none of the cited references, whether considered alone or in combination with any other reference of record, do not anticipate, disclose, teach or suggest all of the limitations of Claims 1, 49-52 and 58, and therefore dependent Claims 2-6, of the present application. It is therefore respectfully requested that the rejection of Claims 1, 49-52 and 58, and therefore dependent Claims 2-6, be reversed and that those Claims be allowed.

**Issue 2 Argument Regarding the Rejection of Independent Claims 1, 49, 50, 51, 52, and 58, and Dependent Claims 2-6, Under 35 U.S.C. §103(a) as Unpatentable over Nicholls in View of Fisher, Kara and Thiel on the Grounds that the Combination of Nicholls, Fisher, Kara and Thiel Render as Obvious the Limitations of the Claims for Displaying a Simultaneous Identification of Shipping Charges for Shipping the Particular Parcel for Each Delivery Service Offered by Each Respective Carrier of the Plurality of Carriers That Would Provide the Requested Delivery Notification Service According to the Request: There is No Disclosure in Nicholls, Fisher, Kara and Thiel for Displaying a Simultaneous Identification of Shipping Charges for Shipping the Particular Parcel for Each Delivery Service Offered by Each Respective Carrier of the Plurality of Carriers That Would Provide the Requested Delivery Notification Service For the Particular Parcel (37 C.F.R. §41.37(c)(1)(vii) subheading)**

The Office Action states that “Fisher and Nichols discloses a multiple carrier system that calculates rates for carriers with specific parameters such as a notification of delivery, however Nicholls discloses the automatic selection of a carrier and fails to disclose ... simultaneously displaying the rates of the carriers to the user.” Office Action, Topic No. 8, p. 3.

In an effort to compensate for the above-quoted statement that “...Nicholls ... fails to disclose simultaneously displaying the rates of the carriers to the user...,” the Office Action asserts that “Kara discloses a computer program ... that ... simultaneously displays rates for multiple carriers and calculate shipping rates of multiple services for multiple carriers (first, second, third and fourth) (See Figure 8, column 22, lines 20-38. Office Action, Topic No. 8, pgs. 3-4. The Office Action then concludes that “[i]t would

have been obvious ... to have the shipping rates of Nicholls be displayed to the user as disclosed by Kara, in order to present the user with information from which to make an informed choice as to a particular shipping service provider by which to ship a particular item. (See Kara, column 22).” Office Action, Topic No. 8, p. 4. Later in the explanation of the rejections, the Office Action states that “Nicholls, Kara and Theil fail to disclose the ‘simultaneous’ display of shipping charges for each service of each carrier ...” but asserts without evidence that “[i]t would have been obvious to ... display all charges simultaneously.” Office Action, Topic No. 10, p. 4.

It is respectfully asserted that, for the reasons described further below, in view of the concession by the Office Action that the cited references fail to disclose simultaneous identification of shipping charges for each delivery service of each carrier, the Office Action fails to support its conclusion of obviousness of the claimed limitations with evidence as required by MPEP §706.02(j) and MPEP §2143.

Applicants respectfully disagree with the aforementioned characterization of Kara by the Office Action. As conceded by the Office Action in Topic 10, at page 4, it is respectfully asserted that Kara fails to disclose simultaneously displaying rates for multiple delivery services for multiple carriers. Yet further, it is respectfully asserted that Kara fails to disclose simultaneously calculating rates for multiple delivery services for multiple carriers.

The Office Action then concludes that “[i]t would have been obvious ... to have the shipping rates of Nicholls displayed to the user as disclosed by Kara, in order to present the user with information from which to make an informed choice as to a particular shipping service provider by which to ship a particular item. (See Kara, column 22).” Office Action, Topic No. 8, p. 4.

Applicants respectfully disagree with the foregoing conclusion of the Office Action and respectfully assert that the Office Action fails to cite evidence of obviousness of the claimed limitations. More specifically, the asserted evidence of obviousness of presenting a user with information for making an informed choice does not in any way teach or suggest the specific limitations of the rejected Claims.

The Office Action then states that "Nicholls, Fisher and Kara, disclose the use of calculating and displaying rates for specific services, for multiple carriers, but fails to disclose the simultaneous display of the rates for each carrier for each service." Office Action, Topic No. 9, Page 4.

In an effort to compensate for the above-quoted statement that "Nicholls, Fisher and Kara ... fail[ ] to disclose the simultaneous display of the rates for each carrier for each service...", the Office Action asserts that "Thiel discloses the use of a system for calculating rates for multiple carriers for multiple services (see abstract), and discloses the computer storing data for the rates of each service for each carrier in one table (Column 11, lines 1-13). Thiel also discloses that the system will walk the user through which service is wanted, however, discloses displaying only the final rate for desired service for multiple carriers (Column 11, lines 46-54)." Office Action, Topic No. 9, p. 4.

It is respectfully asserted that the above-quoted citation to the table of Thiel cited (at Thiel, col. 11, lines 1-13) by the Office Action does not support the assertion by the Office Action that "Thiel discloses ... the computer storing data for the rates of each service for each carrier (the "Thiel Table")".

In comparing the cited Thiel Table to both the features attributed to it in the Office Action, and more importantly, to the claimed limitations of the rejected Claims, it is respectfully asserted that the contents of the cited Thiel Table and the description by Thiel of the use of the cited Thiel Table as described by Thiel are instructive.

At first glance, the cited Thiel Table may appear to provide a stored shipping rate comparison. However, it is respectfully submitted that under close inspection, the cited Thiel Table provides a stored comparison of base rate components, not of calculated shipping rates (as claimed by some of the rejected Claims).

More specifically, the cited Thiel Table is shown as containing shipping feature entries for five (5) different carriers. See Thiel, col. 11, lines 1-13. For each of the five (5) different carriers (Carrier 1-5), the cited Thiel Table shows a shipping feature entry for each of the following shipping features: Destination Zone, Base Charge, Express Delivery, Added [Express Delivery] Charge, Return Receipt, Added [Return Receipt]

Charge, Discount for greater than 100 items, Discount for greater than 1000 items, and Discount for greater than 10000 items. *Id.* at col. 11, lines 1-13.

As compared to *calculating rates* for multiple carriers for multiple services for a *simultaneous display* of rates for multiple services for multiple carriers (as is claimed in one way or another in some of the rejected Claims), it is respectfully submitted that *Thiel* describes the cited *Thiel Table* as a *stored* table of services and fee *components* of various carriers. Further, *Thiel* explains that the cited stored *Thiel Table* is used by the *Thiel* system to "... search[] the carriers which offer the desired services ..." (*Thiel*, col. 11, lines 22-23) and "... [perform] a fee optimization ... to reach the best price ..." (*Thiel*, col. 11, lines 29-30). That is, the cited *Thiel Table* is used by the *Thiel* system to identify carriers that would provide a user-pre-selected delivery service and user-requested shipping features and to calculate shipping rates for shipping a parcel; the cited *Thiel Table* does not contain calculated shipping rates for shipping a parcel.

In an effort to compensate for the above-quoted conclusion that "Thiel ... discloses displaying only the final rate for desired service for multiple carriers ...," the Office Action then asserts that even though "Nicholls, Kara and Theil [sic] fail to disclose the 'simultaneous' display of shipping charges for each service of each carrier ...[, i]t would have been obvious ... to display all charges simultaneously." *Office Action*, Topic No. 10, p. 4.

The Office Action reasons that "All the rates of each service of each carrier are calculated by Nicholls, Kara and Thiel. Thiel even shows all the rates are stored in one table, however, they all require some sort of selection by the user before each charge is displayed." *Office Action*, Topic No. 10, p. 4.

Applicants respectfully disagree that the above-posed obviousness is properly supported by sufficient evidence as required for an obviousness rejection under MPEP §706.02(j) and MPEP §2143. Rather, it is respectfully asserted that the Office Action's concession that a simultaneous display as claimed by the rejected Claims is completely absent from the references cited is strong evidence that such a simultaneous display is not obvious. *Cf., e.g., In re Mahurkar Patent Litigation*, 831 F. Supp. 1354, 1374-75, 28

U.S.P.Q.2d (BNA) 1801, 1817 (N.D. Ill. 1993), *aff'd*, 71 F.3d 1573, 37 U.S.P.Q.2d 1138 (Fed. Cir. 1995).

Even after making the above-stated concessions of the complete absence of a simultaneous display as claimed in one way or another by Claims 1-6, 49-52 and 58, in an effort to justify the rejection under Section 103(a), the Office Action nevertheless asserts that "the way something is displayed, is not considered to be patentable over the prior art of record, therefore it would have been obvious ... to display all the calculated rates simultaneously for comparison purposes." Office Action, Topic No. 10, p.4.

The Office Action then concludes that "[i]t should also be noted that the claims are all drawn to system claims, which are limited to the actual systems and their capabilities, and that what information is actually displayed is considered to be printed matter, and unless the information is used further in the system, then what is actually displayed is considered non-functional." Office Action, Topic No. 10, pgs. 4-5.

For the reasons and authorities given below, it is respectfully asserted that a printed matter rejection is misplaced.

First, with regard to the aforementioned "printed matter" rejection, as the Office Action admits, it is respectfully noted that the rejected claims are directed to computer systems. It is respectfully submitted that computer systems have been well established as being patentable subject matter under 101.

Further, "... when evaluating the scope of a claim, every limitation in the claim must be considered. USPTO personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered." Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility, (United States Patent and Trademark Office; Official Gazette Notices for November 22, 2005), § II.C (citing Diamond v. Diehr, 450 U.S. 175, 188-89, 209 USPQ 1, 9 (1981) ("In determining the eligibility of respondents' claimed process for patent protection under Sec. 101, their claims must be considered as a whole. It is inappropriate to dissect the claims into old and new elements and then to

ignore the presence of the old elements in the analysis. This is particularly true in a process claim because a new combination of steps in a process may be patentable even though all the constituents of the combination were well known and in common use before the combination was made.")).

"The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. *Gulack*, 703 F.2d at 1385. The PTO may not disregard claim limitations comprised of printed matter. See *Gulack*, 703 F.2d at 1384; see also *Diamond v. Diehr*, 450 U.S. 175, 191 (1981)." *In re Lowry*, 32 F.3d 1579, 1582, 32 USPQ2d 1031, 1034 (Fed. Cir. 1994). Further, the *In re Lowry* court noted "... that *Gulack* cautioned against a liberal use of 'printed matter rejections' under section 103 ...." *In re Lowry*, 32 F.3d at 1583, 32 USPQ2d at 1034. "A 'printed matter rejection' under [[section]] 103 stands on questionable legal and logical footing. Standing alone, the description of an element of the invention as printed matter tells nothing about the differences between the invention and the prior art or about whether that invention was suggested by the prior art. . . . [The Court of Customs and Patent Appeals], notably weary of reiterating this point, clearly stated that printed matter may well constitute structural limitations upon which patentability can be predicated." *In re Lowry*, 32 F.3d at 1583, 32 USPQ2d at 1034 (quoting *Gulack*, 703 F.2d at 1385 n.8).

As distinguished for the above-given reasons from the references of record that do not disclose a simultaneous display or identification, Claim 1 recites:

for each respective carrier of the plurality of carriers that would provide electronic mail delivery notification for shipping the particular parcel according to the request, *display* to a display device configured for communication with the particular user client computer device of the user, as to the particular parcel, a *simultaneous identification* of shipping charges for each delivery service offered by the respective carrier to ship the particular parcel according to the parcel shipping specifications.

(Emphasis added).

As distinguished for the above-given reasons from the references of record that do not disclose a simultaneous display or identification, Claim 49 recites:

for each respective carrier of the plurality of carriers that would provide each of the plurality of delivery notification service options for shipping the particular parcel according to the request, *display* to a display device configured for communication with the particular user client computer device of the user, as to the particular parcel, *a simultaneous identification* of shipping charges for each delivery service offered by the respective carrier to ship the particular parcel according to the parcel shipping specifications.

(Emphasis added).

As distinguished for the above-given reasons from the references of record that do not disclose a simultaneous display or identification, Claim 50 recites:

calculate a service-specific, carrier-specific delivery notification service charge by each delivery service offered by each respective carrier of the plurality of carriers for each respective delivery notification service option requested by the respective user that each delivery service offered by each respective carrier would support for delivery of the respective particular parcel; and

display to a display device configured for communication with a user client computer device associated with the at least one respective user, *a simultaneous identification* of each service-specific, carrier-specific delivery notification service charge.

(Emphasis added).

As distinguished for the above-given reasons from the references of record that do not disclose a simultaneous display or identification, Claim 51 recites:

*simultaneously identify* to a respective user of a plurality of users, in response to the respective user's request for at least one delivery notification service option of a plurality of delivery notification service options for shipping a respective parcel, each delivery service offered by each respective carrier of a plurality of carriers that would support each delivery notification service option requested by the respective user for delivery of the respective parcel.

(Emphasis added).

As distinguished for the above-given reasons from the references of record that do not disclose a simultaneous display or identification, Claim 52 recites:

*displaying* to a respective user of a plurality of users, in response to the respective user's request for at least one delivery notification service option of a plurality of delivery notification service options for shipping a respective parcel, *a simultaneous identification* of each delivery service offered by each respective carrier of a plurality of carriers that would provide the delivery notification service

options requested by the respective user for shipping the respective parcel.

(Emphasis added).

As distinguished for the above-given reasons from the references of record that do not disclose a simultaneous display or identification, Claim 58 recites:

- (F) *simultaneously displaying* on a display screen associated with said user:
- (1) a first respective service-specific shipping charge that said first carrier would charge in conjunction with performing said delivery of the parcel according to a first respective delivery service offered by said first carrier, said first respective service-specific shipping charge calculated to include a first respective service-specific service charge associated with the first respective delivery service providing an electronic mail delivery notification for the delivery of the parcel,
  - (2) a second respective service-specific shipping charge that said first carrier would charge in conjunction with performing said delivery of the parcel according to a second respective delivery service offered by said first carrier, said second respective service-specific shipping charge calculated to include a second respective service-specific service charge associated with the second respective delivery service providing an electronic mail delivery notification for the delivery of the parcel,
  - (3) a third respective service-specific shipping charge that said second carrier would charge in conjunction with performing said delivery of the parcel according to a third respective delivery service offered by the second carrier, said third respective service-specific shipping charge calculated to include a third respective service-specific service charge associated with the third respective delivery service providing an electronic mail delivery notification for the delivery of the parcel, and
  - (4) a fourth respective service-specific shipping charge that said second carrier would charge in conjunction with performing said delivery of the parcel according to a fourth respective delivery service offered by said second carrier, said fourth respective service-specific shipping charge calculated to include a fourth respective service-specific service charge associated with the fourth respective delivery service providing an electronic mail delivery notification for the delivery of the parcel.

(Emphasis added).

Yet further, it is respectfully asserted that there is no disclosure in Fisher of any monetary distinction or service level distinction, or of any report or display of any monetary or service level distinction, between shipping charges or service levels



provided by one Fisher carrier or another for providing one type of delivery or another.

As distinguished from Fisher in which there is no disclosure of a monetary distinction or service level distinction between shipping charges or service levels provided by one Fisher carrier or another, it is respectfully asserted that Claim 1, for example, recites limitations that "... for each respective carrier of the plurality of carriers that would provide electronic mail delivery notification for shipping the particular parcel ... display ... a simultaneous identification of *shipping charges* for each delivery service offered by the respective carrier to ship the particular parcel according to the parcel shipping specifications..." (emphasis added). That is, as compared to the Fisher Claim 1, for example, is directed to providing a simultaneous display of shipping charges for various carriers and various delivery service notification.

Similar to Claim 1, as distinguished from Fisher in which there is no disclosure of a monetary distinction or service level distinction between shipping charges or service levels provided by one Fisher carrier or another, it is respectfully asserted that Claim 49 recites:

for each respective carrier of the plurality of carriers that would provide each of the plurality of delivery notification service options for shipping the particular parcel according to the request, *display* to a display device configured for communication with the particular user client computer device of the user, as to the particular parcel, *a simultaneous identification* of shipping charges for each delivery service offered by the respective carrier to ship the particular parcel according to the parcel shipping specifications.

(Emphasis added).

For reasons similar to those described above regarding Claims 1 and 49, it is respectfully submitted that Fisher does not disclose "... display[ing] to a display device configured for communication with a user client computer device associated with the at least one respective user, a simultaneous identification of each service-specific, carrier-specific delivery notification service charge ..." as recited by Claim 50.

For reasons similar to those described above regarding Claims 1, 49, and 50, it is respectfully submitted that Fisher does not disclose "...simultaneously displaying ... service-specific shipping charges ..." for multiple delivery services offered by multiple

carriers as claimed by Claim 58.

As compared to a system such as the one disclosed in Fisher that itself composes a shipment status email message based on a carrier-system interrogation, it is respectfully asserted that Claim 51, for example, recites limitations for "... simultaneously identify[ing] to a respective user of a plurality of users, in response to the respective user's request for at least one delivery notification service option of a plurality of delivery notification service options for shipping a respective parcel, each delivery service offered by each respective carrier of a plurality of carriers that would support each delivery notification service option requested by the respective user for delivery of the respective parcel...." (Emphasis added.) That is, as compared to the Fisher system that itself provides shipment status, Claim 51, for example, is directed to providing a simultaneous identification of "... each delivery service offered by each respective carrier of a plurality of carriers that would support each delivery notification service option requested by the respective user for delivery of the respective parcel...."

For reasons similar to those described above regarding Claim 51, it is respectfully asserted that Fisher does not disclose "... displaying to a respective user of a plurality of users, in response to the respective user's request for at least one delivery notification service option of a plurality of delivery notification service options for shipping a respective parcel, a simultaneous identification of each delivery service offered by each respective carrier of a plurality of carriers that would provide the delivery notification service options requested by the respective user for shipping the respective parcel..." as recited by amended Claim 52.

Further, Claim 1 (*cf. also*, Claim 49), for example, recites that "... a request input by a user ..." is "... for an electronic mail delivery notification service by a *carrier system* ..." (emphasis added) as compared to an electronic mail delivery notification service *by the claimed system*. That is, as compared to a system as in Fisher that discloses *providing* electronic mail delivery notification, e.g., Claim 1 recites "... a request input by a user for an electronic mail delivery notification service *by a carrier system* for shipping a particular parcel ...".

For the reasons given and authorities cited above, it is respectfully asserted that none of the references of record, whether considered alone, or in combination with any other reference, anticipate, disclose, teach or suggest all of the limitations of the independent Claims 1, 49-52 and 58 of the present application.

In view of the above-given reasons and authorities, it is respectfully asserted that the combination of limitations claimed by Claims 1-6, 49-52 and 58 are non-obvious over the references of record. It is therefore respectfully requested that the rejections of Claims 1-6, 49-52 and 58 be reversed and that those Claims be allowed.

**Issue 3 Argument Regarding the Rejection of Independent Claim 28, and Dependent Claims 29-33, Under 35 U.S.C. §103(a) as Unpatentable over Nicholls in View of Pauley, Kara and Thiel on the Grounds that the Combination of Nicholls, Pauley, Kara and Thiel Render as Obvious the Limitations of the Claims for Determining Whether Each Respective Carrier of a Plurality of Carriers Would Provide Verbal Delivery Notification for Shipping a Particular Parcel: There is No Disclosure in Nicholls, Pauley, Kara or Thiel of Determining Whether Each Respective Carrier of a Plurality of Carriers Would Provide Verbal Delivery Notification Service for Shipping a Particular Parcel (37 C.F.R. §41.37(c)(1)(vii) subheading)**

For the reasons given and the authorities cited below, it is respectfully asserted that independent Claim 28, and therefore dependent Claims 29-33, are patentably distinct from the references of record. It is therefore respectfully requested that the rejection of Claim 28, and therefore dependent Claims 29-33, be reversed and that those Claims be allowed. In particular, it is respectfully asserted that none of the references of record, whether considered alone or in combination, disclose, anticipate, teach or suggest all of the limitations recited in independent Claim 28 as discussed in detail in the following paragraphs.

Based on Fig. 4A of Nicholls cited in the Office Action as a basis for rejecting Claims 28-33 (see, e.g., Office Action, Topic No. 16, p. 5), it appears that a user may designate any one of a number of Special Services, such as, for example, Proof of Delivery, and that the Nicholls system will, as a result, calculate a rate that includes any

charge for the Special Services designated. Based on Fig. 4A of Nicholls, it therefore appears that Nicholls presumes that all carriers offer each of the listed Special Services, and thus does not teach determining or identifying whether each respective carrier of a plurality of carriers would provide the requested verbal delivery notification service for shipping a particular parcel, which is claimed by independent Claim 28.

Further, it is respectfully asserted that it may be possible for a carrier to provide a special service, such as, for example, a Proof of Delivery, without requiring any additional charge. Therefore, in the event a rate were calculated that did not include an extra charge for a special service indicated by a user, such as a Proof of Delivery service, such a rate, by itself, would not identify whether the carrier provided the service or did not.

Moreover, the Office Action actually concedes that “Nicholls ... fails to disclose ... determining which carriers provide a selected service....” Office Action, Topic No.17, p. 6.

The Office Action asserts that “Kara discloses a computer program used for multiple shippers that determines if a carrier provides a specific service. Office Action, Topic No. 17, p. 6 (citing Kara, col. 22, lines 13-48). However, as compared to identifying or determining carrier support for providing a particular special service with respect to a particular parcel as claimed in one way or another by Claims 1, 49-52 and 58, and therefore dependent Claims 2-6, the cited portion of Kara explains that “[t]he E-STAMP program will automatically incorporate the ... entered parameters—weight, class, zone—in order to correctly calculate the correct postage ... Where a selected shipping service does not provide a desired shipping and/or delivery parameter, the E-STAMP program may indicate such and provide the fees for a service offered by that particular shipping service provider most near that desired by the user.” Kara, col. 22, lines 13-38.

Notwithstanding the above-cited assertions by the Office Action, it is respectfully asserted that the above-cited disclosure of Kara does not disclose any facility for user input of an indication of any type of special service of a nature of the type claimed.

Rather, according to the above-cited disclosure, Kara discloses consideration of “desired shipping and/or delivery parameters” and mentions the “entered parameters” of “weight, class, zone.” It is respectfully asserted that basic parcel specifications such as weight, and basic shipping parameters such as class and zone, are distinguished from special services that may, or may not be provided by particular carriers.

Moreover, even if it were assumed for the sake of argument only that Kara’s consideration of basic parcel specifications and basic shipping parameters could be considered to be special service options of the nature of the type claimed, it is respectfully asserted that the above-cited disclosure of Kara fails to disclose, anticipate, teach or suggest identifying or determining, for each respective carrier of a plurality of carriers, whether a respective carrier would provide verbal mail delivery notification for shipping *a particular parcel according to specifications of a user’s request*.

It is therefore respectfully asserted that none of the cited references, including Nicholls and Kara, disclose that some carriers may provide a particular special service, and that some carriers may not, with respect to a particular parcel. Moreover, it is respectfully asserted that none of the cited references, including Nicholls and Kara, disclose identifying or determining whether or not a carrier would provide a particular special service with respect to a particular parcel.

As compared to the apparent assumption by some of the references of record that all carriers provide special services, or in the case, for example, of Kara, that if a carrier provides a certain service, that it would do so with respect to all parcels, the Specification of the present application explains:

Another of the problems in dealing with standalone Carrier systems is that, if the Shipper wants verbal notification that a particular parcel has been delivered, the Shipper must attempt to apply each Carrier’s rules for providing a Shipper with verbal notification that a particular parcel has been delivered. Each Carrier’s verbal delivery notification pricing rules must be separately applied by the Shipper to shipment of a particular parcel to determine whether or not the particular Carrier offers verbal delivery notification and if so, the price for the service.

Specification, p. 2, line 29 – p. 3, line 5.

As compared to the apparent assumption by some of the references of record that all carriers provide special services, or in the case, for example, of Kara, that if a carrier provides a certain service, that it would do so with respect to all parcels, Claim 28 recites limitations that reflect the above-cited disclosure of the specification that "...for each respective carrier of the plurality of carriers *that would provide verbal delivery notification* for shipping the particular parcel according to the request ...." (Emphasis added).

It is respectfully asserted that the above-recited limitations of Claim 28, and therefore dependent Claims 29-33, are distinguished from the references of record.

Therefore, it is respectfully asserted that none of the references of record disclose, anticipate, teach or suggest identifying or determining which of a plurality of carriers would provide for delivery of a particular parcel, a verbal delivery notification service and which do not, as claimed by Claim 28, and therefore dependent Claims 29-33.

The Office Action concedes that "Nicholls ... fails to specifically disclose the proof of delivery is a verbal delivery notification ..." (Office Action, Topic No. 16, p. 5), but asserts that "Pauley discloses the use of customer service representatives which provide verbal communication of delivery status ...." Office Action, Topic No. 16, p. 5. The Office Action further asserts that "[i]t would have been obvious ... to have the proof of delivery of Nicholls be the notification by the customer service representative, as disclosed by Pauley ...." Office Action, Topic No. 16, pgs. 5-6. The Office Action further asserts that the aforementioned combination "... would have been obvious ... in order to allow users to obtain delivery information without the use of a computer [citing Pauly, cols. 2 and 4]." Office Action, Topic No. 16, pgs. 5-6.

For the following reasons and authorities, it is respectfully asserted that the combination of Pauly with Nicholls and the other references of record, adds nothing to support the rejection of Claims 28-33. That is because, as further explained below, the disclosure of Pauly is fundamentally different than the limitations of independent Claim 28.

Pauly is directed to a central ordering/inventory system for ongoing fulfillment of disposable contact lens prescriptions. See Pauly, Abstract. Pauly discloses shipping from the centralized inventory to the respective eye care professionals. See, e.g., Pauly, col. 3, lines 1-10.

As compared to the limitations of e.g., Claim 28 for providing a "... display [of] ... a simultaneous identification of shipping charges for each delivery service offered by the respective carrier to ship the particular parcel according to the parcel shipping specifications...", in Pauly, the Pauly system is "... [p]rogram[med] to allow customer service representatives to view orders already generated and learn the status of these orders, picked, shipped, etc. The representatives will also be able to confirm prescriptions as well as ship-to addresses." Pauly, col. 9, lines 34-38.

As compared to the above-cited assertions by the Office Action, it is respectfully submitted that the limitations claimed by Claims 28-33 are not directed to supplying, or in any way providing, verbal communication of delivery status. Rather, Claim 28, for example, recites limitations to "... receive ... a request input by a user for a verbal delivery notification service by a carrier for shipping a particular parcel and an input by the user of parcel specifications for the particular parcel;... and for each respective carrier of the plurality of carriers that would provide verbal delivery notification for shipping the particular parcel according to the request, display ... a simultaneous identification of *shipping charges* for each delivery service offered by the respective carrier to ship the particular parcel according to the parcel shipping specifications." That is, as compared to the assertion by the Office Action that Pauly "... discloses the use of customer service representatives which provide verbal communication of delivery status...", Claim 28, for example, is directed to providing a simultaneous display of *shipping charges* for various carriers and various delivery services that would provide verbal delivery notification for shipping a particular parcel.

Further still, as compared to the assertion by the Office Action that it would have been obvious to make the asserted combination "...in order to allow users to obtain delivery information without the use of a computer ...," it is respectfully asserted that

there is no disclosure in Pauley of carriers themselves providing any type of delivery notification or of any monetary distinction or service level distinction, or of any report or display of any monetary or service level distinction, between shipping charges or service levels provided by one carrier or another for providing one type or another of delivery notification.

In view of the above-described distinctions between the disclosures of the references of record on the one hand, and Claims 28-33, on the other hand, it is respectfully asserted, for the reasons given above, that the references of record, whether considered alone or in combination, do not anticipate, disclose, teach or suggest all of the limitations of Claims 28-33 of the present application. It is therefore respectfully requested that the rejection of Claims 28-33 be reversed and that those Claims be allowed.

**Issue 4 Argument Regarding the Rejection of Independent Claim 28, and Dependent Claims 29-33, Under 35 U.S.C. §103(a) as Unpatentable over Nicholls in View of Pauley, Kara and Thiel on the Grounds that the Combination of Nicholls, Pauley, Kara and Thiel Render as Obvious the Limitations of the Claims for Displaying a Simultaneous Identification of Shipping Charges for Shipping the Particular Parcel for Each Delivery Service Offered by Each Respective Carrier of the Plurality of Carriers That Would Provide Verbal Delivery Notification Service According to the Request: There is No Disclosure in Nicholls, Pauley, Kara and Thiel for Displaying a Simultaneous Identification of Shipping Charges for Shipping the Particular Parcel for Each Delivery Service Offered by Each Respective Carrier of the Plurality of Carriers That Would Provide Verbal Delivery Notification Service (37 C.F.R. §41.37(c)(1)(vii) subheading)**

The Office Action states that “Nicholls and Pauley disclose a multiple carrier system that calculates rates for carriers with specific parameters such as a notification of delivery, however Nicholls discloses the automatic selection of a carrier and fails to disclose simultaneously displaying the rates of the carriers to the user and determining which carriers provided a selected service.” Office Action, Topic No. 17, p. 6.



In an effort to compensate for the above-quoted statement that "...Nicholls ... fails to disclose simultaneously displaying the rates of the carriers to the user...", the Office Action asserts that "Kara discloses a computer program ... that ... determines which carriers can provide a selected service (Column 22, lines 13-48) and displays that calculate shipping rates of multiple carriers for multiple services (See Figure 8, column 22, lines 20-38)". Office Action, Topic No. 17, p. 6. The Office Action then concludes that "[i]t would have been obvious ... to have the shipping rates of Nicholls be displayed to the user as disclosed by Kara, in order to present the user with information from which to make an informed choice as to a particular shipping service provider by which to ship a particular item. (See Kara, column 22)." Office Action, Topic No. 17, p. 6. Later in the explanation of the rejections, the Office Action states that "Nicholls, Pauley and Kara ... fail[] to disclose the simultaneous display of rates for each carrier for each service ..." but asserts that Thiel discloses a "... simultaneous display of rates for each carrier, that includes rates for different services." Office Action, Topic No. 18, p. 6 (citing Thiel, col. 11, lines 1-13).

It is respectfully asserted that, for the reasons described further below, in view of the concession by the Office Action that the cited references fail to disclose simultaneous identification of shipping charges for each delivery service of each carrier, the Office Action fails to support its conclusion of obviousness of the claimed limitations with evidence as required by MPEP §706.02(j) and MPEP §2143.

As conceded by the Office Action in Topic No. 18, at page 6, it is respectfully asserted that Kara fails to disclose simultaneously displaying rates for multiple delivery services for multiple carriers. Yet further, it is respectfully asserted that Kara fails to disclose simultaneously calculating rates for multiple delivery services for multiple carriers.

The Office Action then concludes that "[i]t would have been obvious ... to have the shipping rates of Nicholls be displayed to the user as disclosed by Kara, in order to present the user with information from which to make an informed choice as to a

particular shipping service provider by which to ship a particular item. (See Kara, column 22)." Office Action, Topic No. 17, p. 6.

Applicants respectfully disagree with the foregoing conclusion of the Office Action and respectfully assert that the Office Action fails to cite evidence of obviousness of the claimed limitations. More specifically, the asserted evidence of obviousness of presenting a user with information for making an informed choice does not in any way teach or suggest the specific limitations of the rejected Claims.

The Office Action then states that "Nicholls, Pauley and Kara, disclose the use of calculating and displaying rates for specific services, for multiple carriers, but fails to disclose the simultaneous display of the rates for each carrier for each service." Office Action, Topic No. 18, Page 6.

In an effort to compensate for the above-quoted statement that "Nicholls, Fisher and Kara ... fail[ ] to disclose the simultaneous display of the rates for each carrier for each service...", the Office Action asserts that "Thiel discloses the use of a system for calculating rates for multiple carriers for multiple services (see abstract), and discloses a simultaneous display of rates for each carrier, that includes rates for different services (Column 11, lines 1-13). Thiel discloses displaying rates for the preferred carrier, but also discloses displaying the rates for second and third choices as well (Column 11, lines 46-54)." Office Action, Topic No. 18, p. 6.

It is respectfully asserted that the above-quoted citation to the table of Thiel cited (at Thiel, col. 11, lines 1-13 (the "Thiel Table")) by the Office Action does not support the assertion by the Office Action that "Thiel discloses ... a simultaneous display of rates for each carrier, that includes rates for different services ..." (Office Action, Topic No. 18, p. 6).

In comparing the cited Thiel Table to both the features attributed to it in the Office Action, and more importantly, to the claimed limitations of Claim 28, it is respectfully asserted that the contents of the cited Thiel Table and the description by Thiel of the use of the cited Thiel Table as described by Thiel are instructive.

At first glance, the cited Thiel Table may appear to provide a stored shipping rate comparison. However, it is respectfully submitted that under close inspection, the cited Thiel Table provides a stored comparison of base rate components, not of calculated shipping rates (as claimed by some of the rejected Claims).

More specifically, the cited Thiel Table is shown as containing shipping feature entries for five (5) different carriers. See Thiel, col. 11, lines 1-13. For each of the five (5) different carriers (Carrier 1-5), the cited Thiel Table shows a shipping feature entry for each of the following shipping features: Destination Zone, Base Charge, Express Delivery, Added [Express Delivery] Charge, Return Receipt, Added [Return Receipt] Charge, Discount for greater than 100 items, Discount for greater than 1000 items, and Discount for greater than 10000 items. *Id.* at col. 11, lines 1-13.

As compared to *calculating rates* for multiple carriers for multiple services for a *simultaneous display* of rates for multiple services for multiple carriers (as is claimed in one way or another in some of the rejected Claims), it is respectfully submitted that Thiel describes the cited Thiel Table as a *stored table of services and fee components* of various carriers. Further, Thiel explains that the cited stored Thiel Table is used by the Thiel system to "... search[] the carriers which offer the desired services ..." (Thiel, col. 11, lines 22-23) and "... [perform] a fee optimization ... to reach the best price ..." (Thiel, col. 11, lines 29-30). That is, the cited Thiel Table is used by the Thiel system to identify carriers that would provide a user-pre-selected delivery service and user-requested shipping features and to calculate shipping rates for shipping a parcel; the cited Thiel Table does not contain calculated shipping rates for shipping a parcel.

The Office Action then asserts that "[i]t would have been obvious ... to modify Nicholls, Pauley and Kara, to simultaneously display the rates of each carrier for each service, in order to allow the customer to come to his/her own conclusion and choice of carriers. (See Theil column 11)." Office Action, Topic No. 18, pgs.6-7.

The Office Action defends its assertions stating that "Kara discloses simultaneous displaying of rates for multiple carriers for a selected service. And is fully capable of calculating rates for multiple services for multiple carriers, however is not

done simultaneously. Thiel discloses the rates using the tables are calculated simultaneously, however the output to the user is only the final rate for the selected service. ... [T]he way something is displayed, whether it be simultaneous or by a user interaction ... is not considered to be patentable of the prior art of record.” Office Action, Topic No. 26, p. 9.

Applicants respectfully disagree that the above-cited assertion of obviousness is properly supported by sufficient evidence as required for an obviousness rejection under MPEP §706.02(j) and MPEP §2143. Rather, it is respectfully asserted that the Office Action’s concession that a simultaneous display as claimed by the rejected Claims is completely absent from the references cited is strong evidence that such a simultaneous display is not obvious. *Cf., e.g., In re Mahurkar Patent Litigation*, 831 F. Supp. 1354, 1374-75, 28 U.S.P.Q.2d (BNA) 1801, 1817 (N.D. Ill. 1993), *aff’d*, 71 F.3d 1573, 37 U.S.P.Q.2d 1138 (Fed. Cir. 1995).

Further, the above-cited assertion regarding the way something is displayed is not patentable is taken to amount to a printed matter rejection. However, for the reasons and authorities given below, it is respectfully asserted that a printed matter rejection is misplaced.

First, with regard to the aforementioned “printed matter” rejection, as the Office Action admits (see Office Action, Topic No. 26, p. 9); it is respectfully noted that Claim 28 is directed to a computer system. It is respectfully submitted that computer systems have been well established as being patentable subject matter under 101.

Further, “... when evaluating the scope of a claim, every limitation in the claim must be considered. USPTO personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered.” Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility, (United States Patent and Trademark Office; Official Gazette Notices for November 22, 2005), § II.C (citing Diamond v. Diehr, 450 U.S. 175, 188-89, 209 USPQ 1, 9 (1981) (“In determining the eligibility of respondents’ claimed process for patent protection under Sec. 101, their claims must be considered as a

whole. It is inappropriate to dissect the claims into old and new elements and then to ignore the presence of the old elements in the analysis. This is particularly true in a process claim because a new combination of steps in a process may be patentable even though all the constituents of the combination were well known and in common use before the combination was made.")).

"The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. *Gulack*, 703 F.2d at 1385. The PTO may not disregard claim limitations comprised of printed matter. See *Gulack*, 703 F.2d at 1384; see also *Diamond v. Diehr*, 450 U.S. 175, 191 (1981)." *In re Lowry*, 32 F.3d 1579, 1582, 32 USPQ2d 1031, 1034 (Fed. Cir. 1994). Further, the *In re Lowry* court noted "... that *Gulack* cautioned against a liberal use of 'printed matter rejections' under section 103 ...." *In re Lowry*, 32 F.3d at 1583, 32 USPQ2d at 1034. "A 'printed matter rejection' under [[section]] 103 stands on questionable legal and logical footing. Standing alone, the description of an element of the invention as printed matter tells nothing about the differences between the invention and the prior art or about whether that invention was suggested by the prior art. . . . [The Court of Customs and Patent Appeals], notably weary of reiterating this point, clearly stated that printed matter may well constitute structural limitations upon which patentability can be predicated." *In re Lowry*, 32 F.3d at 1583, 32 USPQ2d at 1034 (quoting *Gulack*, 703 F.2d at 1385 n.8).

As distinguished for the above-given reasons from the references of record that do not disclose a simultaneous display or identification, Claim 28 recites:

for each respective carrier of the plurality of carriers that would provide verbal delivery notification for shipping the particular parcel according to the request, display to a display device configured for communication with the particular user client computer device of the user, as to the particular parcel, *a simultaneous identification of shipping charges* for each delivery service offered by the respective carrier to ship the particular parcel according to the parcel shipping specifications.

(Emphasis added).

Yet further, it is respectfully submitted that there is no disclosure in *Pauly* of any

monetary distinction or service level distinction, or of any report or display of any monetary or service level distinction, between shipping charges or service levels provided by one Pauly carrier or another for providing one type or another of delivery.

As distinguished from Pauly in which there is no disclosure of a monetary distinction or service level distinction between shipping charges or service levels provided by one Pauly carrier or another, it is respectfully asserted that Claim 28 recites limitations that "... *for each respective carrier of the plurality of carriers that would provide verbal delivery notification for shipping the particular parcel according to the request*, display to a display device configured for communication with the particular user client computer device of the user, as to the particular parcel, a simultaneous identification of shipping charges for each delivery service offered by the respective carrier to ship the particular parcel according to the parcel shipping specifications..." (emphasis added). That is, as compared to the Pauly, Claim 28 is directed to providing a simultaneous display of shipping charges for various carriers and various delivery services.

Further, Claim 28 recites that "... a request input by a user ..." is "... *for a verbal delivery notification service by a carrier for shipping a particular parcel ...*" (emphasis added) as compared to a verbal delivery notification service *by the claimed process*. That is, as compared to a process as in Pauly that discloses *providing* verbal delivery notification, e.g., Claim 28 recites that the request is for *a carrier* to provide the requested verbal delivery notification.

For the reasons given and authorities cited above, it is respectfully asserted that none of the references of record, whether considered alone, or in combination with any other reference, anticipate, disclose, teach or suggest all of the limitations of Claims 28-33 of the present application.

In view of the above-given reasons and authorities, it is respectfully asserted that the combination of limitations claimed by Claims 28-33 are non-obvious over the references of record. It is therefore respectfully requested that the rejections of Claims

28-33 be reversed and that those Claims be allowed.

ARGUMENT CONCLUSION

For the above-given reasons and authorities, in view of the above-described distinctions between the disclosures of Nicholls, Fisher, Kara, Pauley, and Thiel on the one hand, and independent Claims 1, 28, 49-52 and 58, and therefore the Claims dependent on independent Claims 1, 28, 49-52 and 58, namely, dependent Claims 2-6 and 29-33, it is respectfully requested that the rejection of Claims 1-6, 28-33, 49-52 and 58 be reversed and that those Claims be allowed.

Respectfully submitted,

KHORSANDI PATENT LAW GROUP, ALC

By Marilyn R. Khorsandi 11/21/07  
Marilyn R. Khorsandi  
Reg. No. 45,744  
626/796-2856

**CLAIMS APPENDIX (37 C.F.R. §41.37(c)(1)(viii) heading)**

**(Double-Spaced as required by MPEP §1205.02)**

**THE CLAIMS ON APPEAL ARE THE PENDING CLAIMS AFTER THE AMENDMENT AND RESPONSE FILED FEBRUARY 14, 2007 IN RESPONSE TO THE OFFICE ACTION DATED NOVEMBER 16, 2006, AND ARE AS FOLLOWS:**

1. A server-based shipping management computer system, said server-based shipping management computer system comprising at least one server computer device, wherein said server-based shipping management computer system is programmed to:

receive from a particular user client computer device of a plurality of user client computer devices, a request input by a user for an electronic mail delivery notification service by a carrier system for shipping a particular parcel and an input by the user of parcel specifications for the particular parcel;

for each respective carrier of a plurality of carriers, determine whether the respective carrier would provide electronic mail delivery notification for shipping the particular parcel according to the request; and

for each respective carrier of the plurality of carriers that would provide electronic mail delivery notification for shipping the particular parcel according to the request, display to a display device configured for communication with the particular user client computer device of the user, as to the particular parcel, a simultaneous identification of



shipping charges for each delivery service offered by the respective carrier to ship the particular parcel according to the parcel shipping specifications.

2. The server-based shipping management computer system of Claim 1, said server-based shipping management computer system further programmed to:

recognize as a user request for an electronic mail delivery notification service by a carrier system for the particular parcel, a user input by the user of a selection of an electronic mail delivery notification indicator.

3. The server-based shipping management computer system of Claim 2, said server-based shipping management computer system further programmed to:

store in a database, a record corresponding to the particular user and to the particular parcel, said record comprising information about the request for electronic mail delivery notification.

4. The server-based shipping management computer system of Claim 3, said server-based shipping management computer system further programmed to:

for each respective carrier of a plurality of carriers that would provide electronic mail delivery notification for shipping the particular parcel according to the request, for each respective service of a plurality of services offered by the respective carrier, calculate a respective service charge for delivering the respective particular parcel via the respective service, wherein each said respective service charge is calculated

according to at least one electronic mail delivery notification rule for the respective service offered by the respective carrier; and

generate a simultaneous online display of the respective service charges to the display device configured for communication with the particular user client computer device of the user.

5. The server-based shipping management computer system of Claim 3, said server-based shipping management computer system further programmed to:

generate a simultaneous online display, to the display device configured for communication with the particular user client computer device of the user, of a plurality of respective service charges associated with shipping the particular parcel, wherein each respective service charge of the plurality of respective service charges is calculated according to a respective set of electronic mail delivery notification rules for the respective delivery service offered by the respective carrier and according to a respective set of service-specific rules of the respective delivery service for shipping said particular parcel.

6. The server-based shipping management computer system of Claim 3, said server-based shipping management computer system further programmed to:

generate a simultaneous online display to the display device configured for communication with the particular user client computer device of the user, of a plurality of shipping rates, wherein each shipping rate of the plurality of shipping rates

corresponds to a respective delivery service offered by a particular carrier of the plurality of carriers that would provide electronic mail delivery notification for shipping the particular parcel according to the request, wherein each shipping rate of the plurality of shipping rates includes an electronic mail delivery notification service charge associated with the respective delivery service shipping the particular parcel according to a set of electronic mail delivery notification rules for the respective delivery service.

28. A server-based shipping management computer system, said server-based shipping management computer system comprising at least one computer device, wherein said server-based shipping management computer system is programmed to:

receive from a particular user client computer devices of a plurality of user client computer devices, a request input by a user for a verbal delivery notification service by a carrier for shipping a particular parcel and an input by the user of parcel specifications for the particular parcel;

for each respective carrier of a plurality of carriers, determine whether the respective carrier would provide verbal delivery notification for shipping the particular parcel according to the request; and

for each respective carrier of the plurality of carriers that would provide verbal delivery notification for shipping the particular parcel according to the request, display to a display device configured for communication with the particular user client computer device of the user, as to the particular parcel, a simultaneous identification of shipping charges for each delivery service offered by the respective carrier to ship the particular

parcel according to the parcel shipping specifications.

29. The server-based shipping management computer system of Claim 28, said server-based shipping management computer system further programmed to:

recognize as a user request for a verbal notification service by a carrier for the particular parcel, a user input by the user of a selection of a verbal delivery notification indicator.

30. The server-based shipping management computer system of Claim 29, said server-based shipping management computer system further programmed to:

store in a database, a record corresponding to the particular user and to the particular parcel, said record comprising information about the request for verbal delivery notification.

31. The server-based shipping management computer system of Claim 30, said server-based shipping management computer system further programmed to:

for each respective carrier of a plurality of carriers that would provide verbal delivery notification for shipping the particular parcel according to the request, for each respective service of a plurality of services offered by the respective carrier, calculate a respective service charge for delivering the respective particular parcel via the respective service, wherein each said respective service charge is calculated according

to at least one verbal delivery notification rule for the respective service offered by the respective carrier; and

generate a simultaneous online display of the respective service charges to the display device configured for communication with the particular user client computer device of the user.

32. The server-based shipping management computer system of Claim 30, said server-based shipping management computer system further programmed to:

generate a simultaneous online display, to the display device configured for communication with the particular user client computer device of the user, of a plurality of respective service charges associated with shipping the particular parcel, wherein each respective service charge of the plurality of respective service charges is calculated according to a respective set of verbal delivery notification rules for the respective delivery service offered by the respective carrier and according to a respective set of service-specific rules of the respective delivery service for shipping said particular parcel.

33. The server-based shipping management computer system of Claim 30, said server-based shipping management computer system further programmed to:

generate a simultaneous online display, to the display device configured for communication with the particular user client computer device of the user, of a plurality of shipping rates, wherein each shipping rate of the plurality of shipping rates

corresponds to a respective delivery service offered by a particular carrier of the plurality of carriers that would provide verbal delivery notification for shipping the particular parcel according to the request, wherein each shipping rate of the plurality of shipping rates includes a verbal delivery notification service charge associated with the respective delivery service shipping the particular parcel according to a set of verbal delivery notification rules for the respective delivery service.

49. A server-based shipping management computer system, said server-based shipping management computer system comprising at least one server computer device, wherein said server-based shipping management computer system is programmed to:

receive from a particular user client computer device of a plurality of user client computer devices, a request input by a user for a plurality of delivery notification service options for shipping a particular parcel and an input by the user of parcel specifications for the particular parcel;

for each respective carrier of a plurality of carriers, determine whether the respective carrier would provide each of the plurality of delivery notification service options for shipping the particular parcel according to the request; and

for each respective carrier of the plurality of carriers that would provide each of the plurality of delivery notification service options for shipping the particular parcel according to the request, display to a display device configured for communication with the particular user client computer device of the user, as to the particular parcel, a

simultaneous identification of shipping charges for each delivery service offered by the respective carrier to ship the particular parcel according to the parcel shipping specifications.

50. A server-based shipping management computer system, said server-based shipping management computer system comprising at least one server computer device, wherein said server-based shipping management computer system is programmed to:

receive from an at least one respective user of a plurality of users, a respective request for an at least one delivery notification service option of a plurality of delivery notification service options for shipping a respective particular parcel;

for each respective carrier of a plurality of carriers, for each respective delivery notification service option of the at least one delivery notification service options, determine whether the respective carrier would provide the respective delivery notification service option for shipping the particular parcel according to the request;

calculate a service-specific, carrier-specific delivery notification service charge by each delivery service offered by each respective carrier of the plurality of carriers for each respective delivery notification service option requested by the respective user that each delivery service offered by each respective carrier would support for delivery of the respective particular parcel; and

display to a display device configured for communication with a user client computer device associated with the at least one respective user, a simultaneous

identification of each service-specific, carrier-specific delivery notification service charge.

51. A shipping management computer system, said computer system comprising at least one computer device, wherein said shipping management computer system is programmed to:

simultaneously identify to a respective user of a plurality of users, in response to the respective user's request for at least one delivery notification service option of a plurality of delivery notification service options for shipping a respective parcel, each delivery service offered by each respective carrier of a plurality of carriers that would support each delivery notification service option requested by the respective user for delivery of the respective parcel.

52. A method using a computer system for managing shipping of a plurality of parcels shipped by any one of a plurality of carriers, wherein said computer system comprises at least one computer device, the method comprising:

displaying to a respective user of a plurality of users, in response to the respective user's request for at least one delivery notification service option of a plurality of delivery notification service options for shipping a respective parcel, a simultaneous identification of each delivery service offered by each respective carrier of a plurality of carriers that would provide the delivery notification service options requested by the respective user for shipping the respective parcel.



58. A shipping management computer system that is configured for:

- (A) allowing a user to select, via a notification option selection, an electronic mail delivery notification option to be offered in conjunction with a delivery of a parcel;
- (B) receiving said notification option selection from said user;
- (C) in response to receiving said notification option selection:
  - (1) identifying, from a plurality of carriers, a first carrier that would offer an electronic mail delivery notification service in conjunction with performing said delivery of the parcel, and
  - (2) identifying, from said plurality of carriers, a second carrier that would offer an electronic mail delivery notification service in conjunction with performing said delivery of the parcel;
- (D) for each delivery service offered by said first carrier, using a first set of electronic mail delivery notification rules defined by said first carrier for the respective delivery service to calculate a respective service-specific service charge that said first carrier would charge for providing an electronic mail delivery notification service in conjunction with performing said delivery of the parcel according to the respective delivery service;
- (E) for each delivery service offered by said second carrier, using a second set of electronic mail delivery notification rules defined by said second carrier for the respective delivery service to calculate a respective service-specific service charge that said second carrier would charge for providing an electronic mail delivery

notification service in conjunction with performing said delivery of the parcel according to the respective delivery service; and

(F) simultaneously displaying on a display screen associated with said user:

- (1) a first respective service-specific shipping charge that said first carrier would charge in conjunction with performing said delivery of the parcel according to a first respective delivery service offered by said first carrier, said first respective service-specific shipping charge calculated to include a first respective service-specific service charge associated with the first respective delivery service providing an electronic mail delivery notification for the delivery of the parcel,
- (2) a second respective service-specific shipping charge that said first carrier would charge in conjunction with performing said delivery of the parcel according to a second respective delivery service offered by said first carrier, said second respective service-specific shipping charge calculated to include a second respective service-specific service charge associated with the second respective delivery service providing an electronic mail delivery notification for the delivery of the parcel,
- (3) a third respective service-specific shipping charge that said second carrier would charge in conjunction with performing said delivery of the parcel according to a third respective delivery service offered by the second carrier, said third respective service-specific shipping charge calculated to include a third respective service-specific service charge associated with the third respective

delivery service providing an electronic mail delivery notification for the delivery of the parcel, and

- (4) a fourth respective service-specific shipping charge that said second carrier would charge in conjunction with performing said delivery of the parcel according to a fourth respective delivery service offered by said second carrier, said fourth respective service-specific shipping charge calculated to include a fourth respective service-specific service charge associated with the fourth respective delivery service providing an electronic mail delivery notification for the delivery of the parcel.

**EVIDENCE APPENDIX (37 C.F.R. §41.37(c)(1)(ix) heading)**

A copy of Nicholls et al. (U.S. Patent No. 5,485,369; "Nicholls") as relied on in the final Office Action dated May 21, 2007 is attached hereto.

A copy of Kara (U.S. Patent No. 6,233,568; "Kara") as relied on in the final Office Action dated May 21, 2007 is attached hereto.

A copy of Thiel (U.S. Patent No. 5,699,258; "Thiel") as relied on in the final Office Action dated May 21, 2007 is attached hereto.

A copy of Fisher et al. (U.S. Patent No. 6,047,264; "Fisher") as relied on in the final Office Action dated May 21, 2007 is attached hereto.

A copy of Pauley et al. (U.S. Patent No. 4,958,280; "Pauley") as relied on in the final Office Action dated May 21, 2007 is attached hereto.

**RELATED PROCEEDINGS APPENDIX (37 C.F.R. §41.37(c)(1)(xi) heading)**

1. A copy of the Notice of Panel Decision from Pre-Appeal Brief Review for Application No. 09/684,871 (Attorney Docket No. PSTM0003/MRK), is attached hereto.
2. A copy of the Notice of Panel Decision from Pre-Appeal Brief Review indicating that Application No. 09/684,861 (Attorney Docket No. PSTM0024/MRK) remains on appeal, is attached hereto.
3. A copy of the Notice of Panel Decision from Pre-Appeal Brief Review indicating that Application No. 09/680,654 (Attorney Docket No. PSTM0015/MRK) remains on appeal, is attached hereto.
4. A copy of the Notice of Panel Decision from Pre-Appeal Brief Review, indicating that Application No. 09/685,077 (Attorney Docket No. PSTM0020/MRK) remains on appeal, is attached hereto.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/684,871	10/06/2000	David Allison Bennett	PSTM0003/MRK/STM	2829

29524 7590 06/07/2006

KHORSANDI PATENT LAW GROUP, A.L.C.  
140 S. LAKE., SUITE 312  
PASADENA, CA 91101-4710

EXAMINER

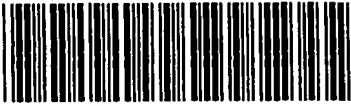
WEBB, JAMISUE A

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 06/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Application Number</b> 	<b>Application/Control No.</b> 09/684,871  John G. Weiss	<b>Applicant(s)/Patent under Reexamination</b> BENNETT ET AL. <b>Art Unit</b> 3629	
<b>Document Code - AP.PRE.DEC</b>			

## Notice of Panel Decision from Pre-Appeal Brief Review



This is in response to the Pre-Appeal Brief Request for Review filed 5/2/06.

1. ☐ **Improper Request** – The Request is improper and a conference will not be held for the following reason(s):

- ☐ The Notice of Appeal has not been filed concurrent with the Pre-Appeal Brief Request.
- ☐ The request does not include reasons why a review is appropriate.
- ☐ A proposed amendment is included with the Pre-Appeal Brief request.
- ☐ Other:

The time period for filing a response continues to run from the receipt date of the Notice of Appeal or from the mail date of the last Office communication, if no Notice of Appeal has been received.

2. ☐ **Proceed to Board of Patent Appeals and Interferences** – A Pre-Appeal Brief conference has been held. The application remains under appeal because there is at least one actual issue for appeal. Applicant is required to submit an appeal brief in accordance with 37 CFR 41.37. The time period for filing an appeal brief will be reset to be one month from mailing this decision, or the balance of the two-month time period running from the receipt of the notice of appeal, whichever is greater. Further, the time period for filing of the appeal brief is extendible under 37 CFR 1.136 based upon the mail date of this decision or the receipt date of the notice of appeal, as applicable.

- ☐ The panel has determined the status of the claim(s) is as follows:
- Claim(s) allowed: \_\_\_\_\_
- Claim(s) objected to: \_\_\_\_\_
- Claim(s) rejected: \_\_\_\_\_
- Claim(s) withdrawn from consideration: \_\_\_\_\_

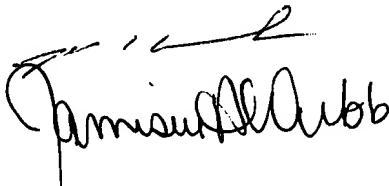
3. ☐ **Allowable application** – A conference has been held. The rejection is withdrawn and a Notice of Allowance will be mailed. Prosecution on the merits remains closed. No further action is required by applicant at this time.

4. ☒ **Reopen Prosecution** – A conference has been held. The rejection is withdrawn and a new Office action will be mailed. No further action is required by applicant at this time.

All participants:

(1) John G. Weiss

(2) Jami Webb



(3) Dean Nguyen

(4) \_\_\_\_\_





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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/684,861

10/06/2000

Paul Bilibin

PSTM0024/MRK

2827

29524

7590

04/18/2006

KHORSANDI PATENT LAW GROUP, A.L.C.  
140 S. LAKE., SUITE 312  
PASADENA, CA 91101-4710

EXAMINER

VAN DOREN, BETH

ART UNIT


PAPER NUMBER

3623

DATE MAILED: 04/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



<b>Application Number</b> 	<b>Application/Control No.</b> 09/684,861 Beth Van Doren	<b>Applicant(s)/Patent under Reexamination</b> BILIBIN ET AL. <b>Art Unit</b> 3623
<b>Document Code - AP.PRE.DEC</b>		

## Notice of Panel Decision from Pre-Appeal Brief Review



This is in response to the Pre-Appeal Brief Request for Review filed 3/20/06.

1. ☐ **Improper Request** – The Request is improper and a conference will not be held for the following reason(s):

- ☐ The Notice of Appeal has not been filed concurrent with the Pre-Appeal Brief Request.
- ☐ The request does not include reasons why a review is appropriate.
- ☐ A proposed amendment is included with the Pre-Appeal Brief request.
- ☐ Other:

The time period for filing a response continues to run from the receipt date of the Notice of Appeal or from the mail date of the last Office communication, if no Notice of Appeal has been received.

2. ☒ **Proceed to Board of Patent Appeals and Interferences** – A Pre-Appeal Brief conference has been held. The application remains under appeal because there is at least one actual issue for appeal. Applicant is required to submit an appeal brief in accordance with 37 CFR 41.37. The time period for filing an appeal brief will be reset to be one month from mailing this decision, or the balance of the two-month time period running from the receipt of the notice of appeal, whichever is greater. Further, the time period for filing of the appeal brief is extendible under 37 CFR 1.136 based upon the mail date of this decision or the receipt date of the notice of appeal, as applicable.

☒ The panel has determined the status of the claim(s) is as follows:  
 Claim(s) allowed: \_\_\_\_\_  
 Claim(s) objected to: \_\_\_\_\_  
 Claim(s) rejected: 1-13 & 15-17 & 19-23.  
 Claim(s) withdrawn from consideration: \_\_\_\_\_

3. ☐ **Allowable application** – A conference has been held. The rejection is withdrawn and a Notice of Allowance will be mailed. Prosecution on the merits remains closed. No further action is required by applicant at this time.

4. ☐ **Reopen Prosecution** – A conference has been held. The rejection is withdrawn and a new Office action will be mailed. No further action is required by applicant at this time.

All participants:

(1) Beth Van Doren *lwd*

(2) Susanna Diaz *SD*

(3) Tariq Hafiz *TH*

(4) \_\_\_\_\_




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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/680,654	10/06/2000	David Allison Bennett	PSTM0015/MRK	9943
29524	7590	05/19/2006	EXAMINER	
KHORSANDI PATENT LAW GROUP, A.L.C. 140 S. LAKE., SUITE 312 PASADENA, CA 91101-4710			WEBB, JAMISUE A	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 05/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Application Number</b> 	<b>Application/Control No.</b> 09/680,654		<b>Applicant(s)/Patent under Re-examination</b> BENNETT ET AL.	
	John G. Weiss		<b>Art Unit</b> 3629	
<b>Document Code - AP.PRE.DEC</b>				

## Notice of Panel Decision from Pre-Appeal Brief Review



This is in response to the Pre-Appeal Brief Request for Review filed 5/2/06.

1. ☐ **Improper Request** – The Request is improper and a conference will not be held for the following reason(s):

- ☐ The Notice of Appeal has not been filed concurrent with the Pre-Appeal Brief Request.
- ☐ The request does not include reasons why a review is appropriate.
- ☐ A proposed amendment is included with the Pre-Appeal Brief request.
- ☐ Other:

The time period for filing a response continues to run from the receipt date of the Notice of Appeal or from the mail date of the last Office communication, if no Notice of Appeal has been received.

2. ☒ **Proceed to Board of Patent Appeals and Interferences** – A Pre-Appeal Brief conference has been held. The application remains under appeal because there is at least one actual issue for appeal. Applicant is required to submit an appeal brief in accordance with 37 CFR 41.37. The time period for filing an appeal brief will be reset to be one month from mailing this decision, or the balance of the two-month time period running from the receipt of the notice of appeal, whichever is greater. Further, the time period for filing of the appeal brief is extendible under 37 CFR 1.136 based upon the mail date of this decision or the receipt date of the notice of appeal, as applicable.

☒ The panel has determined the status of the claim(s) is as follows:  
 Claim(s) allowed: \_\_\_\_\_  
 Claim(s) objected to: \_\_\_\_\_  
 Claim(s) rejected: 1-21,26-52 and 57-70.  
 Claim(s) withdrawn from consideration: \_\_\_\_\_

3. ☐ **Allowable application** – A conference has been held. The rejection is withdrawn and a Notice of Allowance will be mailed. Prosecution on the merits remains closed. No further action is required by applicant at this time.

4. ☐ **Reopen Prosecution** – A conference has been held. The rejection is withdrawn and a new Office action will be mailed. No further action is required by applicant at this time.

All participants:

(1) John G. Weiss

(2) Dean Nguyen

(3) Jami Webb

(4) \_\_\_\_\_



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/685,077	10/06/2000	Paul Bilibin	PSTM0020/MRK/STM	3148
29524	7590	07/21/2006	EXAMINER	
KHORSANDI PATENT LAW GROUP, A.L.C. 140 S. LAKE., SUITE 312 PASADENA, CA 91101-4710			WEBB, JAMISUE A	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 07/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Application Number</b> 	<b>Application/Control No.</b>		<b>Applicant(s)/Patent under Reexamination</b>	
	09/685,077		BILIBIN ET AL.	
	John G. Weiss		<b>Art Unit</b>	
		3629		
<b>Document Code - AP.PRE.DEC</b>				

## Notice of Panel Decision from Pre-Appeal Brief Review



This is in response to the Pre-Appeal Brief Request for Review filed 6/15/06.

1. ☐ **Improper Request** – The Request is improper and a conference will not be held for the following reason(s):

- ☐ The Notice of Appeal has not been filed concurrent with the Pre-Appeal Brief Request.
- ☐ The request does not include reasons why a review is appropriate.
- ☐ A proposed amendment is included with the Pre-Appeal Brief request.
- ☐ Other:

The time period for filing a response continues to run from the receipt date of the Notice of Appeal or from the mail date of the last Office communication, if no Notice of Appeal has been received.

2. ☒ **Proceed to Board of Patent Appeals and Interferences** – A Pre-Appeal Brief conference has been held. The application remains under appeal because there is at least one actual issue for appeal. Applicant is required to submit an appeal brief in accordance with 37 CFR 41.37. The time period for filing an appeal brief will be reset to be one month from mailing this decision, or the balance of the two-month time period running from the receipt of the notice of appeal, whichever is greater. Further, the time period for filing of the appeal brief is extendible under 37 CFR 1.136 based upon the mail date of this decision or the receipt date of the notice of appeal, as applicable.

☒ The panel has determined the status of the claim(s) is as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: 1-7, 58-83

Claim(s) withdrawn from consideration: \_\_\_\_\_

3. ☐ **Allowable application** – A conference has been held. The rejection is withdrawn and a Notice of Allowance will be mailed. Prosecution on the merits remains closed. No further action is required by applicant at this time.

4. ☐ **Reopen Prosecution** – A conference has been held. The rejection is withdrawn and a new Office action will be mailed. No further action is required by applicant at this time.

All participants:

(1) John G. Weiss

(3) Jamisque Webb

(2) Dean Nguyen

(4) \_\_\_\_\_